

1 **REMARKS**

2 **Brief History of Application:**

3 This application ("the application") is a divisional application, the specification  
4 of which originally included claims 1-20. An initial preliminary amendment was filed  
5 along with the application. The initial preliminary amendment canceled claims 1-4, 6,  
6 7, 13, and 15, and amended claims 5, 8, 9, 14, 19, and 20, and added new claims  
21-27.

7 A subsequent preliminary amendment was filed, which canceled claims 5, 8,  
8 9, 14, and 19-27, and added new claims 28-43.

9 A restriction requirement was imposed on claims 28-43. As a result of the  
10 restriction requirement, claims 29, 30, 32, 34, 35, and 40-43 were withdrawn from  
11 consideration, leaving claims 28, 31, 33, and 36-39 remaining for prosecution.

12 **Election/Restriction:**

13 Applicant hereby confirms that Group I, Species VII has been elected for  
14 prosecution.

15 **Rejection of Claims Under 35 U.S.C. 103:**

16 Claims 28, 31, 33, and 36-39 have been rejected under 35 U.S.C. § 103(a) as  
17 being unpatentable over U.S. Patent 6,731,455 to Kulakowski et al. ("Kulakowski") in  
18 view of U.S. Patent 5,329,412 to Stefansky ("Stefansky").

19 As is well known, the standard for a rejection under 35 U.S.C. 103 is provided  
20 by the MPEP, which states, "[t]o establish a *prima facie* case of obviousness, three  
21 basic criteria must be met. First, there must be some suggestion or motivation,  
22 either in the references themselves or in the knowledge generally available to one of  
23 ordinary skill in the art, to modify the reference or to combine the reference  
24 teachings. Second, there must be a reasonable expectation of success. Finally, the  
25 prior art reference (or references when combined) must teach or suggest all the  
claim limitations." (MPEP 706.02(j).)

In regard to claim 28, that claim has been amended as indicated herein  
above. Support for the amendments to claim 28 are found in claims 5, 8, 9-12, 14,  
and 16-27 as shown in the initial preliminary amendment, and which have been

1 previously canceled. Claim 28 has been amended to now include the following  
2 elements:

3 *a host device;*

4 *a first storage media having a tape cartridge form factor and including a hard  
5 disk drive for storage of data;*

6 *a second storage media having the tape cartridge form factor and including a  
7 length of tape for storage of data;*

8 *a picker configured to move the first storage media and the second storage  
9 media; and*

10 *a docking device in communicative linkage with the host device and adapted  
11 to receive the first storage media and the second storage media from the picker.*

12 The Applicant contends that neither Kulakowski nor Stefansky, either  
13 individually or combined, teach all of the limitations and/or elements of claim 28.  
14 Specifically, neither Kulakowski nor Stefansky discloses at least *a docking device in  
15 communication with the host device and adapted to receive the first storage media  
16 and the second storage media from the picker.* For at least this reason, a *prima  
17 facie* case of obviousness is not met with regard to claim 28. Accordingly, the  
18 Applicant respectfully requests that the rejection of claim 28 be withdrawn and that  
19 the claim be allowed.

20 In regard to claims 31, 33, 36, and 39, those claims have been canceled as  
21 indicated herein above. Accordingly, the rejections of those claims are now moot.

22 In regard to claims 37 and 38, those claims have each been amended as  
23 shown herein above to now depend from claim 28. Claims 37 and 38 have also  
24 been amended so as to make the terminology of those claims consistent with the  
25 terminology of claim 28. The Applicant notes that, "[i]f an independent claim is  
nonobvious under 35 U.S.C. 103, then any claim depending therefrom is  
nonobvious." (MPEP 2143.03.)

Thus, the Applicant contends that because claims 37 and 38 depend from  
claim 28, then those claims are nonobvious for the reasons set forth above with  
respect to claim 28. Accordingly, the Applicant respectfully requests that the  
rejections of claims 37 and 38 be withdrawn and that those claims be allowed.

1 New Claims:

2 New claims 44-59 have been added as indicated herein above. Support for  
3 these new claims is found in claims 5, 8, 9-12, 14, and 16-27 as shown in the initial  
4 preliminary amendment, and which have been previously canceled. The Applicant  
5 contends that none of these new claims are anticipated by, or obvious in view of, the  
6 references cited by the Examiner. Accordingly, the Applicant respectfully requests  
7 that claims 44-59 be allowed.

8 SUMMARY

9 The Applicant believes that this communication constitutes a full and complete  
10 response to the Office action, and furthermore requests timely allowance of claims  
11 28, 37, 38, and 44-59.

12 The below-signed attorney respectfully requests that, in the event that the  
13 next Office action is anything other than a Notice of Allowance for claims 28, 37, 38,  
14 and 44-59, the Examiner call him before issuing the action.

15 Respectfully submitted,  
16 Stephen Deckers, Applicant

17 Date: October 13, 2004

18 By



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